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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/875,265 | 06/07/2001 | Masahiko Matsuura | 44318-045 | 4618 |

20277 7590 11/04/2003
MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

BEATTY, ROBERT B

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2852

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,265

Applicant(s)

MATSUURA ET AL.

Examiner

Robert Beatty

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 30-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-41 is/are allowed.
- 6) ☒ Claim(s) 2-8, 30-36, 38 and 43 is/are rejected.
- 7) ☒ Claim(s) 9, 10 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 42, line 2, "said controller", and "the initial condition" lack proper antecedent basis.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-5,30-36,38,43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umeda (JP# 06-67141) in view of Vincent '284.

Umeda teach an image forming apparatus (see Fig.4) comprising a photoconductor 2, a latent image forming device 4, a developing device 28, a transfer roller 7 connected to a bias supply 30, and a fixing device 31. The apparatus also has a first supply tray 25 having a first recording medium 27, and a second supply tray 26 having a re-writable recording medium 1. In operation, if a first supply tray is chosen (i.e. selected by operator) , the latent image information on the photoconductor will be developed with toner and transferred to the recording medium 27; if a second supply tray is chosen, the developing device will be retracted

(image forming element) and the transfer roller (image forming element) grounded such that an image is displayed on this second recording medium via the charged latent image information on the photoconductor. Specifically, Umeda teach all that is claimed except a detector on a media feeding path for detecting the type of media fed (i.e. normal or reverse), a receiver for receiving this detection signal, and a selector that automatically selects the image forming mode (i.e. normal or reverse image formation) from a mode designated in advance, depending on the detected media.

Vincent teach and image forming apparatus (laser printer) that can form images onto normal paper media or a reversible media. As seen in Fig.7, a photosensor 280 will detect the type of media, an inherent controller will receive this signal, and will automatically select the image forming portion that is appropriate to the detected media while disabling the other image forming portion. See col.7, lines 27-32,45-65. For example, the normal image forming will be designated in advance and if a reversible media is detected, the selector will select the reverse image formation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Umeda to have a detector for detecting the types of media fed from the media supply trays and automatically switching to an appropriate image formation because automation is faster than a manually selected mode which will be desirable to the operator from a time stand point. Further, it would have been obvious to one of ordinary skill in the art at the

time the invention was made that the image forming apparatus would be in one of two modes (reverse or normal) and the mode that it is currently in would be considered the designated mode in advance.

3. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umeda (JP# 06-67141) in view of Vincent '284 as applied to claims 2-5,30-36,38,43 above and further in view of Miyasaka et al.

Umeda and Vincent teach everything claimed except specifically stating that the image data is stored in a memory. Miyasaka et al. teach an image forming device which scans an image or has image data sent from a word processor and stores the image data for editing (converting) purposes as well as typical image formation for producing a hard copy. See col.2, lines 29-47. It would have been obvious to one of ordinary skill in the art at the time the invention was made that since both Umeda and Vincent are not analog printers than the image data is digital which inherently must include a storage device for storing the digital image which is taught in the Miyasaka et al. reference. In addition, storing the image data would allow for displaying and editing of the image data before a hard copy output is produced which would conserve resources by eliminating wasteful output.

4. Claims 39-41 are allowable over the prior art of record.

5. Claims 9-10,37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claim 42 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

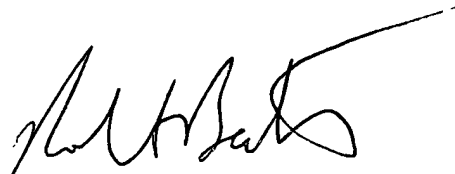
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Beatty whose telephone number is 703-308-1372. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley, can be reached on (703) 308-1373. The fax phone number for the organization where this application or proceeding is assigned is 703-308-3431.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

A handwritten signature in black ink, appearing to read 'Robert Beatty', with a long horizontal line extending from the end of the signature.

Robert Beatty
Primary Examiner
Art Unit 2852

October 31, 2003